

REMARKS

The Office Action in the above-identified application has been carefully considered and this amendment has been presented to place this application in condition for allowance.

Accordingly, reexamination and reconsideration of this application are respectfully requested.

Applicant's herewith seek to amend the specification by adding a paragraph clarifying features of the "relief surface" of the present invention. It is respectfully submitted that no new matter is added by this amendment as the matter added is fully supported by the priority document, U.S. Patent Appn. 08/510,530, to which the present application claims priority. It is submitted that the additional paragraph is supported in the specification of the priority document by the section starting on page 10, line 17-page 11, line 4 and Figs. 3a-3c.

Further, support for the new paragraph can be found the PCT application WO/97 04909. The present application is a divisional of the U.S. national stage of the PCT application. In claims 7 and 11-13 there is recitation of the relief surface having a variety of shapes including V, curvilinear, and square which is located adjacent the cutting surface. Still further, Figs. 5-9 of the present application are substantially similar to Figs 3a-3c of the priority application, and the instant amendment of the specification clarifies the features of these figures. Accordingly, it is respectfully submitted that no new matter has been added by this amendment to the specification.

Claims 26-28 and 30-42 are in the present application. Claim 26 has been amended, claim 29 has been cancelled. It is submitted that these claims, as originally presented, were patentably distinct over the prior art cited by the Examiner, and that these claims were in full compliance with the requirements of 35 U.S.C. § 112. Changes to the claims, as presented herein, are not made for the purpose of patentability within the meaning of 35 U.S.C. sections 101, 102, 103 or 112. Rather, these changes are submitted simply for clarification and to round

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out the scope of protection to which Applicants are entitled. Further, claims 32-42 have been added to clarify additional novel aspects of the present invention.

Initially, the Examiner's indication that claims 27 and 28 contain patentable subject matter and would be allowed if re-written in independent form is appreciated. In response, new claims 30 and 31 have been added by this amendment, which incorporate the Examiner's suggestion. Accordingly, it is respectfully submitted that new claims 30 and 31 patentably distinguish over the cited prior art and are allowable.

In response to the Examiner's requirement for a terminal disclaimer with regard to the subject matter of claim 29, claim 29 has been cancelled. Claim 29 has been cancelled solely for the purposes of furthering prosecution on the merits and in an effort to seek a timely allowance of the pending claims. Such cancellation is made without prejudice and does not create any estoppel. Further, Applicants reserve the right to file one or more divisional applications based upon the subject matter of claim 29, now cancelled.

In the Office Action claim 26 stands rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 3,797,334 to Sinclair.

In response, claim 26 has been amended to clarify distinguishing features of the present invention. It is respectfully submitted that claim 26 as amended patentably distinguishes over Sinclair, for at least the following reasons. Initially, the Sinclair reference does not teach a cavity disposed in the device comprising a portion of a negative image surface of a portion of a tool to be finished. In Sinclair, the tool is finished by the file 28 which acts upon the arrow tip in the groove. Secondly, Sinclair defines a "groove" in the specification as an area bounded by a vertically disposed wall 20 and an inclined wall 22. As such, the groove as defined by Sinclair does not teach a "groove having an active cutting surface" as recited in claim 26 of the present

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invention. As shown in Fig. 3 of Sinclair, the cutting surface is disposed on a file, and not one of the two surfaces that define the groove. Accordingly, it is respectfully submitted that Sinclair does not teach each and every element of the claimed invention. Therefore, claim 26 patentably distinguishes over the cited reference and is allowable. Claims 27-28 which depend from claim 26 are allowable therewith.


It is submitted that claims 32-42 are also patentably distinguishable over the prior art of record in this matter. Accordingly, a Notice of Allowance is earnestly solicited.

The Commissioner is authorized to charge any additional fee that may be required to Deposit Account No. 50-0320.

Respectfully submitted,

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